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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,294	09/26/2003	Shubhasheesh Anand	50269-0600	9385

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HICKMAN PALERMO TRUONG & BECKER, LLP  
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SAN JOSE, CA 95110

EXAMINER
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CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/672,294	<b>Applicant(s)</b> ANAND ET AL.	
	<b>Examiner</b> Donald L. Champagne	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>four documents</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 17-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

At line 4 of each independent claim 17 and 26, “data collected by a search website” is new matter. Indeed, data collection itself is not disclosed by the application as filed.

At each independent claim 17 (line 3) and 26 (line 5), “a search initiated by a user” is new matter. See the discussion in para. 5 below.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At each independent claim 17 (line 4) and 26 (line 5), “a search initiated by a user” is indefinite.
5. The application does not disclose “a search initiated by a user”. The application does disclose a user “performs/performing” a search (para. [0020] and [0021] of the published application, US 20050076130A1). A user “performing” a search necessarily entails a user *initiating* a search, but does not provide support for *initiating* because one of ordinary skill in the art would understand “initiating” to be broader than “perform”. See the Google definitions. “performing” has the common meaning of doing some certain thing to completion, such as performing a wedding, doing the painting or performing a triple

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pirouette. By contrast, "initiate" has the common meaning of starting something without necessarily finishing it, such as initiating a new program or starting a foundation. Hence, in the present context, any action taken by a user which eventually leads to a search reads on initiating a search, and that search, even if one or more steps removed from the user action, reads on "a search initiated by a user".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis et al. (US007089194B1, hereafter "Berstis").

8. Berstis teaches (independent claims 17 and 26) a machine-implemented method and machine-readable medium, the method comprising:

storing, remote to a client, user specific data (*browse history information*, col. 12 lines 4-6) that reflects one or more user interests of a user, wherein said user specific data is collected by a search website that provides searching functionality (the advertising web pages generated by *server 408* read on web pages, col. 12 lines 55-60, and *scans the content of the datastream*, col. 7 lines 1-3, reads on "searching functionality related to a search initiated by a user" (the "user" being the person at *client 402*, col. 6 lines 63-65; see also col. 2 line 61 to col. 3 line 3 and para. 11-12 below);

selecting a set of sponsored content (*advertisements*) to integrate into information generated for display to said user by a non-search application (the application that generates *HTTP response messages*, col. 14 lines 17-24 and col. 3 lines 4-9);

wherein the set of sponsored content is selected based, at least in part, on said user specific data (*browse history information*, col. 14 lines 4-7); and

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integrating said set of sponsored content within said information (col. 3 lines 9-11);  
wherein said non-search application is from a website other than said search website  
(whatever website generated *HTTP response messages*, col. Col. 14 lines 17-24).

9. Note on interpretation of claim terms - Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” (MPEP § 2111.01.III). A “clear definition” must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. An example does not constitute a “clear definition” beyond the scope of the example.
10. In this case, the clause “wherein said user specific data is collected by a search website that provides searching functionality related to a search initiated by a user” is not given a “clear definition” in the specification (MPEP § 2111.01). Indeed, “search website” is disclosed only once in the spec. (in para. [0027] of the published application, US 20050076130A1) and the specification does not disclose either data collection or search “initiation” (See para. 5 above). Hence, the examiner is obligated to give the clause “wherein said user specific data is collected by a search website that provides searching functionality related to a search initiated by a user” its broadest reasonable interpretation, which the examiner judges to be collecting data at any website which provides search capability initiated by a user. *Server 408* taught by Berstis (col. 6 lines 63 to col. 7 line 3) provides search functionality (*scans the datastream*) and the ad-containing web pages generated by *server 408* (col. 12 lines 55-60) read on web pages. The search is initiated by whomever at *client 402* requested the datastream (col. 6 lines 63-65).
11. Berstis also teaches claims 23 and 32 at the citations given above.
12. Berstis also teaches claims 18 and 27 (col. 14 lines 38-42, where *the list of keywords from the browse history* reads on “a word or phrase submitted in a search query, by the user”) and claims 25 and 34 (col. 2 lines 6-7).

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13. Claims 19, 20, 24, 28, 29 and 33 add only non-functional descriptive and were not given patentable weight (MPEP § 2106.01). Claim language not functional when it does not alter how the process steps are to be performed to achieve the utility of the invention. For example, In claims 19 and 20 “a higher priority” is simply a description without functional implications or consequences.
14. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to claims 21, 22, 30, 31 and 35-38 because they depend on non-elected optional claim language in claims 17 and 26 (i.e., “an email application” and “an instant messaging application”).

#### ***Response to Arguments***

15. Applicant's arguments filed with an amendment on 20 November 2008 have been fully considered and addressed in the revised rejection given above.

#### ***Information Disclosure Statements***

16. The Office has received five IDS's in this case. Applicant's IDS filing on 15 July 2005 was certified and mailed to applicant on 22 October 2007. It appears that the other four filings were never certified and mailed to applicant. These filings, as follows, have now been certified and are included herein: 13 January 2004, 4 March 2005, 27 June 2008 and 4 September 2008.

#### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.
21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
22. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
23. Applicant may have after final arguments considered and amendments entered by filing an RCE.
24. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or

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consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

12 June 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688